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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,096	01/19/2001	Stephane Mallol	108407	4500

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EXAMINER

THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

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DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,096

Applicant(s)

MALLOL ET AL.

Examiner

Camie S Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 15-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. Applicant's amendment and accompanying remarks filed on October 25, 2002 have been acknowledged.
2. Examiner acknowledges amended claim 3.
3. Examiner acknowledges newly added claims 15-19 which will be examined with elected claims 1-5, drawn to paper.
4. Applicant argues that Groups I and II are related because a wire is an element used in the paper industry and that the restriction requirement be traversed. Applicant also argues that the subject matter of all groups, claims 1-19 are related. A wire is a completely different invention from paper. In addition, the search requirement for a wire is completely different from that of the search requirements for paper. A method for making a screened image does not necessarily require that the image be made onto paper. A set of masks is a completely different invention from paper, wire and a method for making a screened image and the search requirement would be completely different. The restriction requirement is still deemed proper.

Therefore, the restriction requirement is made FINAL.

5. The objection to the priority document is withdrawn.
6. The objection to the Information Disclosure Statement is withdrawn due to applicant's explanation of English relevance.
7. The rejection of claim 3 under 35 U.S.C. 112, second paragraph is withdrawn due to applicant's amended claim.
8. The rejection of claims 1, 3 and 5 under 35 U.S.C 102(b) as being anticipated by Edwards, U.S. Patent Number 5,388,862 is withdrawn due to applicant's argument.

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9. The rejection of claims 1 and 5 under 35 U.S.C. 102 (b) as being anticipated by Halope et al., U. S. Patent Number 5,275,870 is withdrawn due to applicant's argument.

10. The rejection of claims 1,2 and 4 under 35 U.S.C. 103(a) as being unpatentable over Edwards, U.S. Patent Number 5,388,862 is withdrawn due to applicant's argument.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Doublet et al., U.S. Patent Number 6,402,888.

Doublet discloses a security sheet comprised of cellulose fibers wherein the paper includes localized areas with reduced thickness and opacity in areas determined as watermarks as per instant claim 1 (see column 1, lines 9-21). Also, the reference discloses that an image is obtained

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when the paper is observed by transmitted light as per instant claim 1 (see column 1, lines 36-54). Doublet discloses that there are differences in the density of the paper particularly by means of the watermark and that the darker areas have a fiber density greater than the light areas as per instant claim 2 (column 1, lines 36-54). Column 2, lines 8-30 of the reference disclose that the lighter areas of the paper have a surface area less than 0.4 cm^2 as per instant claim 4. In addition, Doublet discloses that the area of reduced opacity can include colored pigments, fluorescent or luminescent pigments as per instant claim 5 (see column 3, lines 38-43).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1,3 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doublet et al., U.S. 6,402,888 in view of Fedrigoni et al., U.S. Patent Number 5,916,416.

Doublet discloses a security sheet comprised of cellulose fibers wherein the paper includes localized areas with reduced thickness and opacity in areas determined as watermarks as per instant claim 1 (see column 1, lines 9-21). Also, the reference discloses that an image is obtained when the paper is observed by transmitted light as per instant claim 1 (see column 1, lines 36-54). The Doublet reference does not disclose that the image is a portrait as per instant claim 15. Doublet does disclose that the security paper can be used as a banknote or identification papers. Identification papers and banknotes are known to have portraits of images or persons. Therefore, it would have been obvious to one of ordinary skill in the art to have the image of the Doublet

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reference be a portrait. Doublet does not disclose that the screen marks of the watermark are lines as per instant claim 3. Fedrigoni teaches a cellulose fiber paper which has a plurality of watermarks (see column 1, lines 14-50). In addition, Fedrigoni teaches that a dark grey paper affected by parallel line approximately 1.2-1.3 mm wide were significantly lighter in color giving a pinstripe appearance as per instant claim 3 (see column 2, lines 57-60). Fedrigoni does not teach that the lines constitute 50% of the screen marks as per instant claim 15. The number of lines reduces the risk of falsification of the paper and is used as an additional security measures. However, this feature is optimizable. Discovery of optimum values of result effective variables involves only routine skill in the art in *re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA). Therefore, it would have been obvious to one of ordinary skill in the art to have 50% of the screen marks constitute lines in order to provide an additional security measure and reduce the risk of falsification.

Although Fedrigoni teaches that the lines are approximately 1.2-1.3 mm wide, the reference does not teach that the pitch lies in the range of five lines per centimeter to 20 lines per centimeter. The number of lines adds to the originality of the watermark and the paper, thereby, creating an additional security feature. However, this feature is optimizable. Discovery of optimum values of result effective variables involves only routine skill in the art in *re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA). Therefore, it would have been obvious to one of ordinary skill in the art to have the pitch in the range of five lines per centimeter to 20 lines per centimeter in order to provide originality to the watermark.

Neither reference teaches the amplitude modulation, the frequency modulation or the inclination of the lines in the screened image as per instant claims 16, 18 and 19. The screened image of a

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paper is going to have an amplitude modification and a frequency modification, as these are physical properties of the screened image. Therefore, these features are inherent.

The inclination of the lines is used as an additional security measure to prevent falsification.

However, this feature is optimizable. Discovery of optimum values of result effective variables involves only routine skill in the art in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA).

Therefore, it would have been obvious to one of ordinary skill in the art to have the lines inclined at 45° in order to provide for additional security to prevent falsification.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (703) 305-4488. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (703) 308-0449. The fax phone numbers for the Group are (703) 872-9310 {before finals} and (703) 872-9311 {after finals}.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY
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